UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/545,034	04/06/2000	Eduardo Cue	P2512/560	9025

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EXAMINER
ZURITA, JAMES H

ART UNIT	PAPER NUMBER
3625	

DATE MAILED: 07/20/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

	Application No.	Applicant(s)
Office Action Summary	09/545,034	CUE ET AL.
	Examiner	**Art Unit**	
	James H. Zurita	3625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>04 May 2005</u>.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>74-80</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>74-80</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on <u>30 July 2003</u> is/are: a)☒ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage
application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)	4) ☐ Interview Summary (PTO-413)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date. _____ .
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)	5) ☐ Notice of Informal Patent Application (PTO-152)
Paper No(s)/Mail Date _____.	6) ☐ Other: _____ .

DETAILED ACTION

Prosecution History

On 6 April 2000, applicant filed the present application. There are no claims to priority.

On 30 April 2003, the Examiner's first office action rejected claims 1-72 as unpatentable over Blinn (6058373) and Henson (US 6167383).

On 30 July 2003, applicant cancelled claim 72 and amended claims 1, 10, 11, 23, 24, 26, 27, 34, 39, 41, 51, 54-56 and 69-71.

On 15 October 2003, the Examiner, in a Final Office Action, rejected claims 1-71 as unpatentable over Blinn and Henson.

On 23 February 2004, applicant cancelled claims 3, 20, 21 and 58, amended other claims and requested reconsideration.

On 10 March 2004, the Examiner found the request for reconsideration to be non-persuasive and issued an Advisory Action.

On 22 March 2004, applicant requested continued examination.

On 1 July 2004, the Examiner, in a First Office Action following the Request for Continued Examination, rejected pending claims 1-2, 4-19, 22-57 and 59-71 as unpatentable over Blinn and Henson.

On 1 November 2004, applicant cancelled claims 14, 25-72 and added claim 73.

On 4 February 2005, the Examiner issued a second final action, rejecting the pending claims as unpatentable over Blinn and Henson.

On 4 May 2005, applicant filed a second request for continued examination.

Applicant cancelled all pending claims and added claims 74-80.

The present office action is a response to the second request for continued

examination.

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set

forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this

application is eligible for continued examination under 37 CFR 1.114, and the fee set

forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action

has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 4 May

2005 has been entered.

Response to Amendment

On 4 May 2005, applicant cancelled all pending claims and added claims 74-80.

Claims 74-80 are pending and will be examined.

Response to Arguments

Applicant's arguments filed 4 May 2005 have been fully considered but they are

not persuasive.

> To reduce the issues under consideration, and clarify the distinctions over the
> prior art, all of the previously pending have been cancelled, and new claims 74-80 are
> presented herein.
> Claim 74 recites a system for presenting customized information at an electronic
> commerce site. The claimed system includes a database that stores information relating

to products offered by a vendor, and an administration application that enables an administrator to record configuration data in the database that defines a custom store.

The claimed system further includes a custom store application that is responsive to a *request* for *access* to the vendor's electronic commerce site to determine whether the *request* originated from a predetermined host. If the *request* originated from the predetermined host, the custom store application generates and returns a custom store page that is based upon the configuration data. [Ex.note: there is no mention of granting or denying access].

Applicant's arguments fail to comply with 37 CFR 1.111(b) because they amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references.

Applicant argues (emphasis added):

For example, as described in the application with reference to Figure 4, a customer can *access* the vendor's electronic commerce site by means of a web page associated with a particular organization that has established a custom store, such as a university. If the customer *access*es the electronic commerce site via this route, the custom store application is able to determine that the *request* originated from the university website. In that case, therefore, the custom store retrieves the configuration data relating to the university's custom store, and returns a web page relating to the custom store, rather than the main web page of the electronic commerce site. if the customer attempts to *access* the custom store via a different route, for example by directly entering the URL for the custom store page, such *access* is *deni*ed.

It is respectfully submitted that the cited references do not disclose this claimed subject matter. Specifically, they do not disclose the concept of returning a custom store page in dependence upon whether a *request* for *access* to an electronic commerce site originated from a predetermined host, e.g. a university server. Rather, to the extent that the references disclose the display of customized information at an electronic commerce site, such display is dependent upon the identification of the user, rather than upon recognition of the host from which a *request* was sent.

In response to these arguments, the Examiner respectfully notes that the latest set of amendments do not mention of granting or denying access. The claims merely refer to examining a HTTP referrer header field and generating pages.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine,
> manufacture, or composition of matter, or any new and useful improvement
> thereof, may obtain a patent therefor, subject to the conditions and
> requirements of this title.

Claim 74 and claims dependent thereupon are rejected under 35 U.S.C. 101

because the claimed invention is directed to non-statutory subject matter.

The basis of this rejection is set forth in a two-prong test of:

(1) whether the invention is within the technological arts; and

(2) whether the invention produces a useful, concrete, and tangible result.

Technological Arts Analysis

For a claimed invention to be statutory, the claimed invention must be within the

technological arts. Mere ideas in the abstract (i.e., abstract idea, law of nature, natural

phenomena) that do not apply, involve, use, or advance the technological arts fail to

promote the "progress of science and the useful arts" (i.e., the physical sciences as

opposed to social sciences, for example) and therefore are found to be non-statutory

subject matter. For a process claim to pass muster, the recited process must somehow

apply, involve, use, or advance the technological arts. The phrase "technological arts"

has been created and used by the courts to offer another view of the term "useful arts".

See *In re Musgrave*, 167 USPQ (BNA) 280 (CCPA 1970). Moreover, the courts have

found that a claimed computer implemented process was within the "technological art"

because the claimed invention was an operation being performed by a computer within

a computer. See *In re Toma*, 197 USPQ (BNA) 852 (CCPA 1978). Finally, the Board of

Patent Appeals and Interferences (BPAI) has recently affirmed a §101 rejection finding

the claimed invention to be non-statutory based on a lack of technology. See *Ex parte Bowman*, 61 USPQ2d (BNA) 1669 (BdPatApp&Int 2001).

State Street Analysis

Despite the express language of §101, several judicially created exceptions have been established to exclude certain subject matter as being patentable subject matter covered by §101. These exceptions include "laws of nature", "natural phenomena", and "abstract ideas". See *Diamond v. Diehr*, 450, U.S. 175, 185, 209 USPQ (BNA) 1, 7 (1981). However, the courts have found that even if an invention incorporates abstract ideas, such as mathematical algorithms, the invention may nevertheless be statutory subject matter if the invention as a whole produces a "useful, concrete and tangible result." See *State Street Bank & Trust Co. v. Signature Financial Group, Inc.* 149 F.3d 1368, 1973, 47 USPQ2d (BNA) 1596 (Fed. Cir. 1998). Furthermore, the court found that there was no "business method exception" since the court decisions that purported to create such exceptions were based on novelty or lack of enablement issues and not on statutory grounds. Thus, in order for a claimed invention to be statutory, the claimed invention must produce a useful, concrete and tangible result.

> *["Usefulness" may be evidenced by, but not limited to, a specific utility of the claimed invention. "Concreteness" may be evidenced by, but not limited to, repeatability and/or implementation without undue experimentation. "Tangibility" may be evidenced by, but not limited to, a real or actual effect.]*

In the present case, independent claim 74 is directed to a database, and two applications. The claim refers to a system and is regarded an article claim, but fails to recite any structural elements. The Examiner notes applicant's use of "...database..."

A database is any aggregation of data.[1] The recitation "...storing information relating to products offered by a vendor at an electronic commerce..." appears to be nonfunctional descriptive material and does not convert the feature into eligible statutory material.

The two applications, which applicant labels "...administrative application..." and "...custom store application..." appear to be software *per se*. See MPEP 2106.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 74-80 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 74 use of *"...and/or..."* is indefinite, since the presence of the slash precludes recognizing infringement of the claims. For purposes of this Examination, the Examiner will interpret the term "...products *and/or* non-standard pricing for said products..." as identifying a customer such that the custom store presents the customer with different discounted prices.

In claims 74, the term *"...dynamically..."* renders the claims indefinite. For purposes of this Examination, the Examiner will interpret the term as referring to actions that take place when one uses a computer.

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[1] Definition of *database*, MICROSOFT Computer Dictionary, 1993.

In claims 74 and 78, the term *"...predetermined..."* renders the claims indefinite. The term appears to refer to activities that take place outside the metes and bounds of the claims. For purposes of this Examination, the Examiner will interpret "...predetermined host..." to refer to a portion of URL information that is used by the system to recognize a customer as being in a particular customer group based upon the link used to access an online store.

In claim 76 the term *obsolete* is a relative term that renders the claim indefinite. Please note that this issue was also discussed in a prior office action of 25 April 2003, The term "obsolete" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. There is no mention of who determines that a part or product is obsolete. Further, since parts and products in computers can be upgraded and exchanged, it is not clear what makes a part or product obsolete. For purposes of this examination, the term obsolete will be interpreted to refer to compatibility among computer components.

In claim 77, the term *automatically* renders the claim indefinite. For purposes of this Examination, the Examiner will interpret the term as referring to actions that take place when one uses a computer, such as when one uses a button on a web page.

In claims 74, 75, 79, 80, the term *request* renders the claims indefinite. There appear to be two types of request: request for access, as in claim 74, and an HTTP request, claims 75 and 80. Claim 79 refers to *said* request [for access], while claim 80 appears to refer to the HTTP request of claim 75. The term is indefinite since it is not

clear that each HTTP request is necessarily a request for access, or other type of

request.

In claim 80, the term "...identification..." is indefinite. previous claims refer to

"...determination..." For purposes of this Examination, the Examiner will interpret the

term as referring to the ability of a custom store site to identify a customer as belonging

to a particular set of customers.

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can

be found in a prior Office action.

Claims 74, 76-79 are rejected under 35 U.S.C. 103(a) as being unpatentable

over Henson (US 6,167,383) in view of Blinn (US 6058373).

In the absence of specific definitions, the following terms will be given their

broadest reasonable interpretation. Vendor, administrator, customer, custom store

page,

As per claim 74, Henson discloses a system for presenting customized

information at an electronic commerce site, comprising:

- **Database(s)** storing information relating to products offered by a vendor at an

    electronic commerce site. See, for example, at least Fig. 1 and related text for

    databases. The databases also store data that defines a custom store that provides

    customers with a restricted set of products and non-standard (discounted) pricing for

    products. See, for example, references to database-driven customization of

multiple stores for multiple customer sets, Col. 2, lines 27-48. See also generating

different store views for particular customer sets, Col. 3, lines 36-43. See also

references to database-stored merchandising options, Col. 9, lines 26-39.

- *application(s)* (modules) that permit users

    o <u>to view stored information</u> relating to products offered by a vendor at the

       electronic commerce site. See, for example, configurator web page, as in

       Col. 3,lines 12-29.

    o <u>to store in a database</u> configuration data that defines a custom store that

       provides customers with a restricted set of products and non-standard

       (discounted) pricing for the products. See references to database-driven

       customization of multiple stores for multiple customer sets, Col. 2, lines 27-

       48. See generating different store views for particular customer sets,

       customizable per customer, Col. 3, lines 36-43. See also references to

       database-stored merchandising options, Col. 9, lines 26-39.

- *application(s) (modules)* responsive to a request for access to said electronic

  commerce site

    o <u>to determine</u> whether the request originated from a predetermined host. See,

       for example, at least Col. 14, lines 19-41, for references to predetermined

       host www. dell.com, by checking link information in an http request.

    o <u>dynamically generating and returning</u> a custom store page (e.g., federal site

       page) based upon configuration data if the request originated from

predetermined host(s).   See also, for example, at least Col. 14, lines 4-61

concerning Premier Pages.

Henson *does not* specifically disclose how customer-set specific data such as

product, pricing and merchandising data is originally inserted/added/stored into various

databases. Blinn discloses applications that provide <u>administrator interfaces.</u> See, for

example, in Blinn, references to merchant clients, as in Col. 10, line 63-Col. 11, line 29.

These clients contain interfaces such as web browsers, that permit merchants to

administer their database stored product information, as disclosed by Blinn's Merchant

System, Col. 11, line 30-Col. 31, line 32.

It would have been obvious to one of ordinary skill in the art at the time the

invention was made to combine Henson and Blinn to disclose application(s) that provide

Administrator(s) with interface(s) to both view said information relating to said products

and to store in said database configuration data that defines a custom store that

provides customers with a restricted set of said products and non-standard pricing for

said products.

One of ordinary skill in the art at the time the invention was made would have

been motivated to combine Henson and Blinn to disclose application(s) that provide

Administrator(s) with interface(s) to both view said information relating to said products

and to store in said database configuration data that defines a custom store that

provides customers with a restricted set of said products and non-standard pricing for

said products for the obvious reason that users, including administrators, often need

interfaces to interact with computers to store data in databases.

Henson and Blinn do not use the labels "...administrative application that

provides an administrator with an interface..." "...administrative application that provides

an administrator with an interface...to store in said database configuration data..."

"...custom store application..." "...administrators..." However, the labels given to

various actors and modules are not functionally related to the substrate of the article of

manufacture. The labels themselves carry little or no patentable weight. Thus, this

descriptive material will not distinguish the claimed invention from the prior art in terms

of patentability, see *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir.

1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

Therefore, it would have been obvious to a person of ordinary skill in the art at

the time the invention was made to apply a label to various actors and modules in a

system such as Henson because such data does not functionally relate to the substrate

of the article of manufacture and merely labeling the data differently from that in the

prior art would have been obvious. See *Gulack* cited above.

As per claim 76, Henson does not specifically refer to a "...reconciliation..."

application that determines whether said configuration data includes information elating

to products that have become obsolete and provides notification to the administrator if

such information is included in the configuration data. See, for example, at least

references to issuing warnings concerning compatibility issues among system

components, as in Col. 7, line 57-Col. 8, line 6.

As per claim 77, Henson discloses that the database stores standard prices for

products, that the data may include discount pricing information, and that application(s)

may automatically calculate discounted prices from stored standard prices and display

them on web pages. See, for example, reference to **update price** buttons, that trigger

functions that automatically calculate prices according to selections, as in Figs. 3A, 3B

and 3C and related text. Configuration data may include discount pricing information,

as in Col. 10, lines 19-48 concerning applicable discounts. See also at least Col. 10,

lines 19-48, concerning discounts available to customers of various customer sets.

As per claim 78, Henson discloses that the database stores configuration data

for a plurality of different custom stores (Col. 14, lines 4-18). Henson discloses that a

custom store application may select configuration data that is associated with the

identified host to generate and return custom store page(s). See Col. 14, lines 4-61,

which disclose that configuration data may determine what a customer is allowed to see

when he is identified as belonging to a particular custom store.

As per claim 79, Henson discloses that a request may include an indication of

the custom store to be selected. See, for example, Col. 14, lines 19-61.

Claims 75 and 80 are rejected under 35 U.S.C. 103(a) as being unpatentable

over Henson (US 6,167,383) in view of Blinn (US 6058373) and further in view of Fields

(US 6,704797).

As per claims 75 and 80, Henson discloses that a custom store application may

make a determination that a request for access originated from a predetermined host by

examining embedded identifiers in an HTTP header. See, for example, Col. 14, lines

19-61 for information and identifier information contained in HTTP headers. Henson

and Blinn *do not* specifically disclose that the particular identifier is _referrer_ header field

of the HTTP request. This feature is disclosed by Fields. See, for example, Fields, Col. 4, line 44-67, Col. 6, lines 1-26.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Henson and Fields to disclose having custom store applications make a determination by examining a *referrer* header field in an HTTP request. One of ordinary skill in the art at the time the invention was made would have been motivated to combine Henson and Fields to disclose having custom store applications make a determination by examining a *referrer* header field in an HTTP request for the obvious reason that it is important to provide for Internet information distribution techniques that is lightweight, uses existing protocols and that is completely transparent to the end user.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James H. Zurita whose telephone number is 571-272-6766. The examiner can normally be reached on 8a-5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wynn Coggins can be reached on 571-272-7159. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the

Patent Application Information Retrieval (PAIR) system. Status information for

published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see http://pair-direct.uspto.gov. Should

you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free).

James Zurita
Patent Examiner
Art Unit 3625
16 July 2005